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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/017,241
Filing Date: December 14, 2001
Appellant(s): QUINE ET AL.

George M. Macdonald Reg. No. 39,284
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/06/2006 appealing from the Office action mailed 10/07/2005.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0065891	Malik	5-2002
6829607	Tafoya et al.	12-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Claims 1 – 29 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 5, 8 – 21 and 24 – 29 are rejected under 35 U.S.C. 102(e) as being anticipated by

Malik U.S. Publication No. 2002/0065891.

Referencing claim 1, as closely interpreted by the Examiner, Malik teaches a method for correcting an e-mail address, the method comprising:

parsing a domain portion of the e-mail address, (e.g., ¶ 0031);

identifying a format requirement corresponding to the domain portion in a domain name database, (e.g., ¶ 0039 – 0040); and

providing a format suggestion based on the identified format, (e.g., ¶ 0039 – 0040).

Referencing claim 2, as closely interpreted by the Examiner, Malik teaches parsing an identifier portion of the e-mail address, (e.g., ¶ 0031 & ¶ 0042);

determining whether the identifier portion is consistent with the identified format requirement, (e.g., ¶ 0039 – 0040); and

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providing an indication of whether the identifier portion is consistent with the identified format requirement, (e.g., ¶ 0039 – 0040).

Referencing claim 3, as closely interpreted by the Examiner, Malik teaches the step of determining further comprises:

receiving addressee information about an addressee to whom a message is intended at the e-mail address, (e.g., ¶ 0039 – 0040); and

determining whether the addressee information is consistent with the identifier portion and the identified format requirement, (e.g., ¶ 0039 – 0040),

wherein the addressee information provides information in addition to the e-mail address, (e.g., ¶ 0043-0044 & 0048-0051).

Referencing claim 4, as closely interpreted by the Examiner, Malik teaches the addressee information is a name of the addressee, (e.g., ¶ 0042 – 0043).

Referencing claim 5, as closely interpreted by the Examiner, Malik teaches the identified format requirement is a function of an addressee's name, and the step of determining further comprises: comparing the identifier portion to a list of known names, (e.g., ¶ 0031 & 0043 – 0045); and making a determination of whether the identifier portion is consistent with one or more known names under the identified format requirement, (e.g., ¶ 0039 – 0040 & 0043 – 0045).

Referencing claim 8, as closely interpreted by the Examiner, Malik teaches the step of:

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providing a suggested correction that complies with the identified format requirement, (e.g., Abstract).

Referencing claim 9, as closely interpreted by the Examiner, Malik teaches receiving addressee information about an addressee to whom a message is intended at the e-mail address, (e.g., ¶ 0035 – 0036); and

wherein the step of providing the suggested correction includes generating the suggested correction based on the addressee information, (e.g., Abstract & ¶ 0008),

wherein the addressee information provides information in addition to the e-mail address, (e.g., ¶ 0043-0044 & 0048-0051).

Referencing claim 10, as closely interpreted by the Examiner, Malik teaches the addressee information is a name of the addressee, (e.g., ¶ 0042).

Referencing claim 11, as closely interpreted by the Examiner, Malik teaches the step of gathering the addressee information from the message intended to the addressee, (e.g., ¶ 0035 – 0036).

Referencing claim 12, as closely interpreted by the Examiner, Malik teaches the steps of:

determining whether the domain portion complies with domain formulation rules, (e.g., ¶ 0039 – 0040); and

providing an indication whether the domain portion complies with domain formulation rules, (e.g., ¶ 0039 – 0040).

Referencing claim 14, as closely interpreted by the Examiner, Malik teaches the steps of:

comparing the domain portion to a list of known domain names, (e.g., ¶ 0037);

if the domain portion is not in the list of known domain names, determining one or more known

domain names for which the domain portion may be a misspelling, (e.g., ¶ 0037 & 0049); and

providing the one or more known domain names as potential alternative spellings for the domain portion, (e.g., ¶ 0037 & 0049).

Referencing claim 15, as closely interpreted by the Examiner, Malik teaches the steps of:

identifying a second format requirement corresponding to the one or more known alternative spelling domain names, (e.g., ¶ 0037 & 0049); and

providing a preferred alternative spelling for the domain portion based on whether the second format requirement for the one or more known alternative domain spellings is consistent with the identifier portion of the e-mail address, (e.g., ¶ 0037 & 0049).

Claims 13, 16 – 21 and 24 – 29 are rejected for similar reasons stated above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik as applied to claims 1, 2, 5, 16 and 21 above, and in further view of Tafoya et al. (6829607), (hereinafter Tafoya).

As per claim 6, as closely interpreted by the Examiner, Malik does not specifically teach the identified format requirement is a function of the addressee's first name and last name, the list of known names includes first names and last names, and the step of comparing the identifier portion to a list of known names further comprises:

comparing a first sub-portion of the identifier portion to the list of known first names; and comparing a second sub-portion of the identifier portion to the list of known last names. Tafoya teaches the identified format requirement is a function of the addressee's first name and last name, the list of known names includes first names and last names, and the step of comparing the identifier portion to a list of known names further comprises:

comparing a first sub-portion of the identifier portion to the list of known first names, (e.g., col. 13, line 46 – col. 14, line 20 & Table 1 & Figure 6); and

comparing a second sub-portion of the identifier portion to the list of known last names, (e.g., col. 13, line 46 – col. 14, line 20 & Table 1 & Figure 6). It would have been obvious to one of ordinary skill in the art, at the time the invention was conceived, to combine Tafoya with Malik because utilizing a sub portion look-up allows efficient email addressing by minimizing users' keystrokes and mouse clicks.

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Referencing claim 7, as closely interpreted by the Examiner, Malik teaches does not specifically teach teaches the step of making the determination further comprises:

utilizing a statistical frequency of the known names to determine a score relating to whether the domain portion is consistent with one or more known names under the identified format requirement, (e.g., ¶ 0035 – 0036), but does not specifically teach utilizing a statistical frequency of the known names to determine a score relating to whether the identifier portion is consistent with one or more known names under the identified format requirement.

Tafoya teaches the step of making the determination further comprises:

utilizing a statistical frequency of the known names to determine a score relating to whether the identifier portion is consistent with one or more known names under the identified format requirement, (e.g., col. 10, lines 13 – 50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Tafoya with Malik because utilizing a type of score, “weight”, would give the user faster access to email addresses that are utilized more than others and eliminate email addresses that are not utilized often enough from a determination list therefore allowing quicker determination as to which email addresses are “most likely” relevant to the users message.

Claims 22 and 23 are rejected for similar reasons as stated above.

Response to Arguments

Applicant's arguments filed 07/20/2005 have been fully considered but they are not persuasive.

In the Remarks, Applicant argues in substance that Malik does not teach or fairly suggest identifying a format requirement. Even when Malik describes a look-up check for a unique identifier portion of an address, there is no discussion of an abstract format rule applied to addresses at a particular domain.

As to part 1, Examiner would first like to draw the Applicant's attention to the claim language of claim 1 in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an abstract format rule applied to addresses at a particular domain) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also, Malik inherently teaches identifying a format requirement if the interceptor/parser 21 and checker 22 have to use the domain name to look up information about the domain in the domain name database 20. If Malik didn't know the format requirements of an email address then Malik's invention would not be able to perform the functions of finding a domain name in the domain name database.

Furthermore, Applicant does not state what specific "requirements" are needed in the claim language, example, is there an "@" symbol, is there any miss-spellings, etc., as seen in claim 1. Therefore, rejection still stands as previously stated.

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In the Remarks, Applicant argues in substance that Malik does not teach or describe limitations taught in claims 2, 4 and 10.

As to part 2, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the Remarks, Applicant argues in substance that Malik does not teach or suggest using a person's name, such as the first and last names described in the specification.

As to part 3, Examiner would like to draw the Applicant's attention to the claim language of claim 5, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., using a person's name, such as the first and last names described in the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In-re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

What is taught is using an addressee's name. This means that it could be first, last or a nickname that is associated with a user, example BigJohn. Applicant can find the teachings of claim 5 in Malik as cited above.

In the Remarks, Applicant argues in substance that Tafoya describes only comparing a single string as input to both first and last names and does not describe comparing two sub-portions of

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the string and certainly not comparing a first sub-portion to first names and a second sub-portion to last names.

As to part 4, Examiner would like to draw the Applicant's attention to the claim language and prior art that can be interpreted into said claim language. If an identifier can be an addressee's first and last name and the first "sub-portion" can be identified as a first name and a second "sub-portion" can be identified as a last name, then if a user decides to type a name the invention of Tafoya will search for first and last names in a database, which are sub-sections, and come up with a first and a second sub-sections in the search. For example, if a user types in "dav", the searches for the first and second sub-section which could be narrowed down to "David" as a first name or "Davis" as a last name. Applicant is reminded that there is no sections of the claim language that state this operation is done independently or together, therefore, the prior art reads on the claim language as broadly interpreted as disclosed possible.

In the Remarks, Applicant argues in substance that Malik does not teach the limitations taught in claim 7.

As to part 5, Applicant's arguments with respect to claim 7 have been considered but are moot in view of the new ground(s) of rejection.

(10) Response to Argument

In the Arguments, Appellant argues in substance that Malik does not specifically teach or fairly suggest identifying a format requirement. As quoted by the Appellant, "The meaning of

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the term format requirement is clear from the specification to include an abstract format rule applied to addresses at a particular domain such as “first.last” or “LLLLLFF” and an alternative interpretation has not been articulated and supported in the Final rejection.”

As to the first argument, Examiner as already stated in the previous Office Action that arguments that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., rule applied to addresses at a particular domain such as “first.last” or “LLLLLFF”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). All that is claimed in this aspect of the Appellant’s invention is “identifying a format requirement corresponding to the domain portion in a domain name database”. Although the Appellant’s interpretation of the claim language does fall under this limitation, there are numerous other interpretations to this very broad claim limitation. Furthermore, Malik clearly teaches this limitation as broadly as it is stated. Firstly, Appellant does not state, **in the claim language**, what a “format requirement” consists of, which leaves room for it to be interpreted as identifying the right spelling requirement needed for the e-mail address to be sent to its destination. As cited in the prior art of Malik in paragraphs [0039] et seq., *“As an alternative, the checker can be configured to search for domain names that are spelled similarly to the extracted domain name. When a user provides an e-mail address with a domain name that is not similar to any domain name in the database, ... By only searching for words that are likely to have been mistyped or misspelled, the e-mail checker will cause less distraction for the user. Furthermore, because*

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most e-mail addressing errors result from misspelled or mistyped domain names, this checking algorithm may be equally effective in detecting incorrect or invalid e-mail addresses.” Also in Malik in paragraph [0040], “There are numerous methods for detecting whether a user-provided domain name is similar to one or more domain names stored in the domain name database to perform a spell-checking operation. As one example, the e-mail checker can check each alpha-numeric character of the domain names in the database against those in the extracted domain name. The system can then generate a prompt when there is at least one but no more than two discrepancies between a reference domain name and the extracted domain name. The e-mail checker can also remove alpha-numeric characters from the extracted domain name, perhaps one at a time, and search the domain name database for a domain name having at least each of the remaining alpha-numeric characters. These algorithms will likely detect errors that occur when a user misspells a word by inadvertently switching two letters. The e-mail checker can also compare the extracted domain against the reference domain names according to basic grammar rules, as is known in conventional spell-checking software.”

As very apparent in the prior art, Malik teaches identifying the domain name in the e-mail address and a format requirement, i.e., spelling, which corresponds to a database, i.e., searching for names in the database and comparing with a domain names in a database.

Examiner also reminds the Appellant when reviewing a reference the Appellant should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226

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USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

In the Arguments, Appellant argues in substance that Malik does not specifically teach or describe an identified format requirement, or determining whether the identifier portion is consistent with the identified format requirement.

As to the second argument, Appellant has confirmed that Malik teaches the claimed subject matter as shown in paragraph [0042], *"Although many e-mail addressing errors occur in the domain name of the email address, addressing errors can also occur from misspelled or mistyped usernames at the beginning of the e-mail address. In the second embodiment of the present invention, which can be utilized separately or in conjunction with the first embodiment, the entire e-mail address is checked in a personalized e-mail address directory. The e-mail address directory, which is preferably stored on the user's client-side computer, can be incorporated into business/personal contact organizer systems that are available in many conventional e-mail communication software packages. Prior to transmitting an e-mail message composed by the user, the email system performs an e-mail address check against the database*

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of e-mail addresses stored in the personalized address directory.” It is very apparent from the quoted section of the prior art, and what is well known in the prior art, that the usernames “**at the beginning of the e-mail address**” can also be known as the identifier portion of the of the email address. Furthermore, Malik teaches the “identified format requirement” by correcting the misspelled username and the domain name as stated above and throughout the prior art of Malik.

In the Arguments, Appellant argues in substance that Malik describes only usernames which are part of the e-mail address and does not teach or fairly suggest using a name or information in addition to the email address regarding claim 4.

As to the third Argument, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., using a name or information in addition to the email address) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). What is claimed in claim 4 is the addressee information **IS** a name of the addressee, not “**in addition**” as argued by the Appellant.

Appellant is asked to read the above response to the second Argument for it is similar in nature. The prior art uses the **username** as stated above.

Furthermore, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the Arguments, Appellant argues in substance that, regarding claim 5, Malik does not teach or suggest using a person's name, such as the first and last names described in the specification, but rather Malik describes only a username lookup without any description of first or last names.

As to the forth Argument, in response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which applicant relies (i.e., such as the first and last names) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant's arguments further fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Furthermore, this argument was already addressed in the previous Office Action, stated above, in which Examiner stated that the prior art utilized the username, which could be the first or the last or both or a nickname of an intended user. Furthermore, the prior art teaches checking usernames in a database for misspellings as stated in paragraph [0042] et seq., which could be interpreted as any user name, first, last, both or nickname, that was given to a particular client.

In the Arguments, Appellant argues in substance that, in regards to claim 8, Malik does not teach or describe providing a suggested correction or an identified format requirement.

As to the fifth Argument, Appellant is asked to draw their attention to the above responses to arguments in regards to “an identified format requirement”, for they apply to this response with equal weight. Also, the claim language states “providing a suggested correction that complies with the identified format requirement” which can be interpreted as the suggested correction is applied to the email address since there is no claim language that states the “providing” step is displayed or the user has a selection to choose from. All that is stated is that a suggested correction is provided. This could also be interpreted as the domain names that are stored in the database that are provided to a checker for comparison. All of these interpretations are taught by Malik as stated in paragraphs [0039] et seq., *“as one example, the e-mail checker can check each alpha-numeric character of the domain names in the database against those in the extracted domain name.”*

Furthermore, the Appellant does not distinguish if the “identified format requirement” is for the domain or the identifier part of the e-mail address. In any case, Malik teaches that the identifier part, “user name”, of the e-mail address is check against the database of e-mail addresses or otherwise put, a database is provided for the e-mail checker to provide a suggested correction the submitted e-mail address, paragraph [0042].

In the Arguments, Appellant argues in substance that Malik does not teach the name of an addressee, or addressee information, as stated in claims 10 and 11.

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As to the sixth Argument, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant is asked to view the above responses to their arguments, for the same responses can be applied here.

In the Arguments, Appellant argues in substance that Malik does not teach or suggest “providing a preferred alternative spelling for the domain portion based on whether the second format requirement for the one or more known alternative domain spellings is consistent with the identifier portion of the e-mail.”

As to the seventh Argument, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. As to the interpretation of the claim language, what is disclosed is another possible “alternative” to what a domain could be in light of the misspelling of the domain name. It is well known in the prior art of Malik that there are multiple domain names in the database that the checker cross-references. Therefore, the database provides multiple possibilities that the domain name could be when it is provided to the checker. As stated above in the responses to the Appellant's arguments, Malik teaches the claim language as disclosed by the Appellant and the responses to the arguments above can be applied here also.

In the Arguments, Appellant argues in substance that Malik describes removing domain names that have been infrequently used as determined by referring to frequency of use data and certainly does not teach or fairly suggest “utilizing a statistical frequency of the known names to determine a score relating to whether the identifier portion is consistent with one or more known names under the identified format requirements.” Furthermore, there is nothing in the cited passage of Tafoya suggesting utilizing a statistical frequency of the known names to determine a score relating to whether the identifier portion is consistent with one or more known names under the identified format requirement.

As to the eighth Argument, Firstly Appellant discloses that Malik does not teach the “utilizing a statistical frequency of the known names to determine a score relating to whether the identifier portion is consistent with one or more known names under the identified format requirements,” which the Examiner has stated that Malik was not intended for this limitation. Secondly, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference of Tafoya. As shown in the Abstract and the proceeding specification of Tafoya, the weight from the resolution list is given to an email address from the frequency of use the entries having a higher weight will be provided before matching entries having a lower weight where multiple entries match user input, (column 4, lines 57 – 67). This in conjunction with Malik would be obvious to combine to teach the claimed invention as disclosed above in the prior Office Action.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

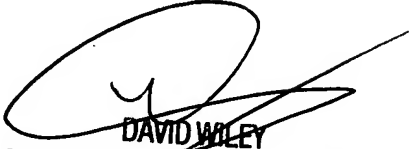
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

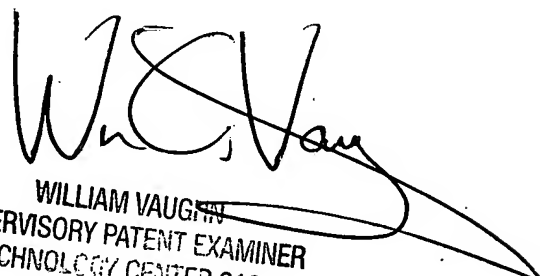
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